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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,819	01/30/2001	Kathleen E. Rodgers	98,365-B1	3008

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MCDONNELL BOEHNEN HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

AUDET, MAURY A

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 08/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/772,819

Applicant(s)

RODGERS ET AL.

Examiner

Maury Audet

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 49-66 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept.

In accordance with 37 CFR 1.142, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Claims 49-66, drawn to a method of treating or promoting a bone disorder that results in weakened bones, using a polypeptide:

#### **Items 1-44**

1. drawn to a method of using a polypeptide of angiotensinogen, classified in class 514, subclass 2.
2. drawn to a method of using a polypeptide of SEQ ID NO: 1, classified in class 514, subclass 16.
3. drawn to a method of using a polypeptide of SEQ ID NO: 2, classified in class 514, subclass 16.
4. drawn to a method of using a polypeptide of SEQ ID NO: 3, classified in class 514, subclass 17.
5. drawn to a method of using a polypeptide of SEQ ID NO: 4, classified in class 514, subclass 16.
6. drawn to a method of using a polypeptide of SEQ ID NO: 5, classified in class 514, subclass 17.

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7. drawn to a method of using a polypeptide of SEQ ID NO: 6, classified in class 514, subclass 17.
8. drawn to a method of using a polypeptide of SEQ ID NO: 7, classified in class 514, subclass 18.
9. drawn to a method of using a polypeptide of SEQ ID NO: 8, classified in class 514, subclass 17.
10. drawn to a method of using a polypeptide of SEQ ID NO: 9, classified in class 514, subclass 17.
11. drawn to a method of using a polypeptide of SEQ ID NO: 10, classified in class 514, subclass 18.
12. drawn to a method of using a polypeptide of SEQ ID NO: 11, classified in class 514, subclass 18.
13. drawn to a method of using a polypeptide of SEQ ID NO: 12, classified in class 514, subclass 16.
14. drawn to a method of using a polypeptide of SEQ ID NO: 13, classified in class 514, subclass 16.
15. drawn to a method of using a polypeptide of SEQ ID NO: 16, classified in class 514, subclass 16.
16. drawn to a method of using a polypeptide of SEQ ID NO: 17, classified in class 514, subclass 16.
17. drawn to a method of using a polypeptide of SEQ ID NO: 18, classified in class 514, subclass 16.

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18. drawn to a method of using a polypeptide of SEQ ID NO: 19, classified in class 514, subclass 16.
19. drawn to a method of using a polypeptide of SEQ ID NO: 20, classified in class 514, subclass 16.
20. drawn to a method of using a polypeptide of SEQ ID NO: 21, classified in class 514, subclass 15.
21. drawn to a method of using a polypeptide of SEQ ID NO: 22, classified in class 514, subclass 16.
22. drawn to a method of using a polypeptide of SEQ ID NO: 23, classified in class 514, subclass 16.
23. drawn to a method of using a polypeptide of SEQ ID NO: 24, classified in class 514, subclass 16.
24. drawn to a method of using a polypeptide of SEQ ID NO: 25, classified in class 514, subclass 16.
25. drawn to a method of using a polypeptide of SEQ ID NO: 26, classified in class 514, subclass 16.
26. drawn to a method of using a polypeptide of SEQ ID NO: 27, classified in class 514, subclass 16.
27. drawn to a method of using a polypeptide of SEQ ID NO: 28, classified in class 514, subclass 16.
28. drawn to a method of using a polypeptide of SEQ ID NO: 29, classified in class 514, subclass 16.

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29. drawn to a method of using a polypeptide of SEQ ID NO: 30, classified in class 514, subclass 16.
30. drawn to a method of using a polypeptide of SEQ ID NO: 32, classified in class 514, subclass 16.
31. drawn to a method of using a polypeptide of SEQ ID NO: 32, classified in class 514, subclass 16.
32. drawn to a method of using a polypeptide of SEQ ID NO: 33, classified in class 514, subclass 16.
33. drawn to a method of using a polypeptide of SEQ ID NO: 34, classified in class 514, subclass 16.
34. drawn to a method of using a polypeptide of SEQ ID NO: 35, classified in class 514, subclass 15.
35. drawn to a method of using a polypeptide of SEQ ID NO: 36, classified in class 514, subclass 16.
36. drawn to a method of using a polypeptide of SEQ ID NO: 37, classified in class 514, subclass 16.
37. drawn to a method of using a polypeptide of SEQ ID NO: 38, classified in class 514, subclass 15.
38. drawn to a method of using a polypeptide of SEQ ID NO: 39, classified in class 514, subclass 16.
39. drawn to a method of using a polypeptide of SEQ ID NO: 40, classified in class 514, subclass 16.

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40. drawn to a method of using a polypeptide of SEQ ID NO: 41, classified in class 514, subclass 16.
41. drawn to a method of using a polypeptide of SEQ ID NO: 42, classified in class 514, subclass 16.
42. drawn to a method of using a polypeptide of SEQ ID NO: 43, classified in class 514, subclass 16.
43. drawn to a method of using a polypeptide of SEQ ID NO: 44, classified in class 514, subclass 16.
44. drawn to a method of using a polypeptide of SEQ ID NO: 45, classified in class 514, subclass 16.

The inventions are distinct, each from the other because of the following reasons:

The methods of Items 1-44 are drawn to methods of treating or preventing a bone disorder that results in weakened bones comprising the step of administering patentably distinct and structurally different peptides. If any one of Items 1-37 is elected, then the elected item will be examined only in so far as it pertains to the elected invention.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference, which would anticipate the invention of one group, would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue

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burden to examine all of the above inventions in one application. Restriction for examination purposes is therefore proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not necessarily required for Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 703-305-5039. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached at 703-306-3220. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-1234 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

MA

August 19, 2003



CHRISTOPHER R. TATE  
PRIMARY EXAMINER